

# BEST AVAILABLE COPY

12/09/2005 15:25

7709510933

THOMAS, KAYDEN

PAGE 11

Serial No.: 10/632,491  
Art Unit: 1732

## REMARKS

This is a full and timely response to the outstanding non-final Office Action mailed September 9, 2005. Through this response, claims 1, 4, 5, 7-20, and 22-23 have been amended, claim 24 has been added, and claims 6 and 21 have been canceled without prejudice, waiver, or disclaimer. Reconsideration and allowance of the application and pending claims 1-5, 7-20 and 22-24 are respectfully requested.

### I. Specification Objections

The specification has been objected to for not having the serial number of the co-pending application. Applicants have amended accordingly. Although this amendment effects a change to the specification, it is respectfully asserted that no new matter has been added. It is Applicants' belief that the specification, as amended, is not objectionable and it is therefore respectfully requested that the objection be withdrawn.

### II. Claim Rejections - 35 U.S.C. § 103(a)

#### A. Rejection of Claims

Claims 1, 2, 4, 5, 7, 8, 22, 23 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Battle* ("Battle," U.S. Pat. No. 5,358214) in view of *Cross* ("Cross," U.S. Pat. No. 1,494,953). Claims 3 and 6 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Battle* in view of *Cross*, and further in view of *Rasmussen* ("Rasmussen," U.S. Pat. No. 2,475,435). Claims 9-21 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Battle* in view of *Cross*, and further in view of *Knipper* ("Knipper," U.S.

Serial No.: 10/632,491  
Art Unit: 1732

Pat. No. 3,509,250), *Rasmussen* and *Wittke* ("Wittke," U.S. Pat. No. 2,532,049). Applicants respectfully traverse these rejections.

**B. Discussion of the Rejection**

As has been acknowledged by the Court of Appeals for the Federal Circuit, the U.S. Patent and Trademark Office ("USPTO") has the burden under section 103 to establish a proper case of obviousness by showing some objective teaching in the prior art or generally available knowledge of one of ordinary skill in the art that would lead that individual to the claimed invention. See *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). Accordingly, to make a proper case for obviousness, there must be a prior art teaching or established knowledge that would suggest to a person having ordinary skill in the pertinent art to fill the voids apparent in the applied reference. It is respectfully asserted that no such case has been made in the outstanding Office Action.

**Independent Claim 1 and Dependent Claims 2, 4, 5, 7, 8, 22, and 23**

Claim 1 recites (with emphasis added):

1. A method for forming a masonry unit, said method comprising the steps of:  
*raising a pallet to a bottom surface of a mold;*  
*inserting a filler plug into the side of the mold between a partition plate and a pallet;*  
dispensing mix into the mold;  
compressing the mix with a shoe; and  
responsive to the compressing, forming a masonry unit with a filler plug effect.

Assuming *arguendo* the combination of *Battle* and *Cross* to be proper, Applicants respectfully submit that *Battle* and *Cross* do not disclose, teach, or suggest at least the emphasized claim

Serial No.: 10/632,491  
Art Unit: 1732

features. *Battle* fails to disclose, teach, or suggest a pallet, and *Cross* does not disclose, teach, or suggest at least *raising a pallet to a bottom surface of a mold*, as recited in independent claim 1. Thus, applicants respectfully request that the rejection to independent claim 1 be withdrawn.

Because independent claim 1 is allowable over *Battle* and *Cross*, dependent claims 2-5, 7-20, and 22-23 are allowable as a matter of law for at least the reason that the dependent claims 2-5, 7-20, and 22-23 contain all elements of their respective base claim. See, e.g., *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

Additionally, Applicants respectfully traverse the findings of inherency and well-known art asserted in the Office Action. For instance, with regard to dependent claim 5, the Office Action alleges inherency in creating a mortar buffer surface. The standard imposed in the Manual of Patent Examining Procedure (MPEP) regarding inherency, section 2163.07(a), is as follows:

"To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted).

There is nothing in *Battle* to indicate that the recesses formed by the strips in *Battle* are configured for mortar disposition, and given the position of the slots for inserting the strips and the nature of the end product (modular precastings), it appears unlikely that mortar would ever be applied. Thus, Applicants respectfully traverse this finding of inherency.

With regard to dependent claims 7 and 8 and the alleged inherency in forming gussets, Applicants respectfully disagree. The Office Action is equating the fillets (12) with side gussets,

Serial No.: 10/632,491  
Art Unit: 1732

the fillets appearing in Figure 2 to run flush with the sidewalls 6, which Applicants do not believe is an accurate characterization of the fillets in that the fillets would not appear to be used to form *side* gussets (with or without an angle of inclination).

With regard to the finding of well-known art, Applicants respectfully traverse this finding of well-known art and submit that the subject matter noted above should not be considered well known since the Office Action does not include specific factual findings predicated on sound technical and scientific reasoning to support the conclusions, as required. The MPEP defines the standard for taking official notice. As provided in MPEP § 2144.03:

Official notice without documentary evidence to support an examiner's conclusion is permissible only in some circumstances. While "official notice" may be relied on, these circumstances should be rare when an application is under final rejection or action under 37 CFR 1.113. Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known. As noted by the court in *In re Ahlert*, 424, F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be "capable of such instant and unquestionable demonstration as to defy dispute" (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 USPQ 6 (CCPA 1961)).

As provided in MPEP § 2144.03 (emphasis added):

If applicant adequately traverses the examiner's assertion of official notice, *the examiner must provide documentary evidence in the next Office action* if the rejection is to be maintained. See 37 CFR 1.104(c)(2).

Applicants respectfully submit that in the context of the claim language, such a finding of well-known art is improper given the added complexity associated with such features as inserting a filler plug and forming a masonry unit with a filler plug effect. Accordingly, Applicants traverse the

Serial No.: 10/632,491  
Art Unit: 1732

Examiner's use of official notice. Because of this traversal, the Examiner must support his finding with evidence, or withdraw the official notice determination.

In addition to the above described defects of the rejection, Applicants respectfully assert that the proposed combination of *Battle* and *Cross* is improper. It has been well established that teachings of references can be combined only if there is some suggestion or incentive to do so.

*ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). Accordingly, there must be a teaching in the relevant art which would suggest to a person having ordinary skill in the art the desirability of at least "compressing the mix with a shoe" and "responsive to the compressing, forming a masonry unit with a filler plug effect." The *Battle* reference simply discloses concrete modular precastings, with no suggestion that compression by a shoe is needed or desired. Similar castings may be performed on a job site (and thus not pre-formed), where compression is certainly not used nor required. Thus, Applicants respectfully submit that the proposed combination is improper, and respectfully request that the rejection be withdrawn.

#### **Dependent Claims 3 and 6**

Applicants have cancelled claim 6 and have incorporate the subject matter of claim 6 into independent claim 1, and thus discussion of the claim 6 features are discussed in the context of independent claim 1. Assuming *arguendo* the combination of references to be proper, Applicants respectfully submit that the proposed combination fails to disclose, teach, or suggest "stripping the architectural concrete masonry unit from the mold by lowering the pallet" as recited in claim 3 or "raising a pallet to a bottom surface of a mold" as recited in independent claim 1. The Office Action provides (on page 3) the following assertion:

Serial No.: 10/632,491  
Art Unit: 1732

Rasmussen teaches a method in which the pallet (Fig. 3, Item 20) would have necessarily have been lowered to remove the block.

Applicants respectfully disagree. As provided in column 3, lines 21-30 of *Rasmussen*:

The mixture used is intended to be sufficiently stiff as to be non-slumping, thus permitting the core 21 to be immediately removed and the elements G to be withdrawn, leaving the dovetailed grooves 33 accurately molded in the side faces of the block B, following which the latch 17 is released and the form opened as indicated in broken lines in figure 1, to leave the molded block supported by the pallet 20, upon removal of the form therefrom.

As described above, the form is opened, and thus it is likely that the block is simply lifted from the pallet without moving the pallet. Nothing in *Rasmussen* supports the claim 3 features of "stripping the architectural concrete masonry unit from the mold by lowering the pallet," and thus Applicants respectfully submit that the rejection be withdrawn.

With regard to claim 6 (with features now found in independent claim 1), the Office Action alleges that "Rasmussen's pallet is raised to join with the mold." This simply is not supported in *Rasmussen*, and thus Applicants respectfully request that such features incorporated into independent claim 1 are patentable over the proposed combination of references.

Additionally, Applicants respectfully note that the independent claim features are not disclosed, taught, or suggested by the proposed combination of *Cross* and *Battle*, and Applicants further submit that the other cited references fail to remedy these deficiencies. Because dependent claim 3 incorporates the independent claim features, Applicants respectfully submit that dependent claim 3 is allowable as a matter of law.

Further, in addition to the above described defects of the rejection, Applicants respectfully submit that the proposed combination of references are improper, as explained above

Serial No.: 10/632,491  
Art Unit: 1732

in association with *Battle* and *Cross*, and thus respectfully request that the rejection be withdrawn.

### **Dependent Claims 9-21**

Applicants have canceled claim 21, and have amended claims 9-20 to recite method limitations for the same, and respectfully submit that the rejection to claims 9-20 are rendered moot.

Additionally, Applicants respectfully note that the independent claim features are not disclosed, taught, or suggested by the proposed combination of *Cross* and *Battle*, and Applicants further submit that the other cited references fail to remedy these deficiencies. Because dependent claims 9-20 incorporate the independent claim features, Applicants respectfully submit that dependent claims 9-20 are allowable as a matter of law.

In addition to the above described defects of the rejection, Applicants respectfully submit that the proposed combination of *Cross* and *Battle* is improper as explained above, and thus respectfully request that the rejection be withdrawn.

Further, Applicants respectfully submit that the proposed combination using *Knipper* is improper. *Knipper* has nothing to do with methods for forming masonry units, but in quite considerable contrast, is directed to a method and apparatus for making window frames. Thus, Applicants respectfully request that the rejection to claims 9-20 be withdrawn.

### **III. Canceled Claims**

As identified above, claims 6 and 21 have been canceled from the application through this Response without prejudice, waiver, or disclaimer. Applicants reserve the right to present these canceled claims, or variants thereof, in continuing applications to be filed subsequently.

Serial No.: 10/632,491  
Art Unit: 1732

**IV. New Claims**

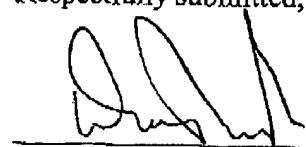
As identified above, claim 24 has been added into the application through this Response. Applicants respectfully submit that these new claims describe an invention novel and unobvious in view of the prior art of record and, therefore, respectfully request that these claims be held to be allowable.

Serial No.: 10/632,491  
Art Unit: 1732

**CONCLUSION**

Applicants respectfully submit that Applicants' pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. Any other statements in the Office Action that are not explicitly addressed herein are not intended to be admitted. In addition, any and all findings of inherency are traversed as not having been shown to be necessarily present. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,



\_\_\_\_\_  
David Rodack  
Registration No. 47,034

**THOMAS, KAYDEN,  
HORSTEMEYER & RISLEY, L.L.P.**  
Suite 1750  
100 Galleria Parkway N.W.  
Atlanta, Georgia 30339  
(770) 933-9500

**This Page is Inserted by IFW Indexing and Scanning  
Operations and is not part of the Official Record**

**BEST AVAILABLE IMAGES**

Defective images within this document are accurate representations of the original documents submitted by the applicant.

Defects in the images include but are not limited to the items checked:

- BLACK BORDERS**
- IMAGE CUT OFF AT TOP, BOTTOM OR SIDES**
- FADED TEXT OR DRAWING**
- BLURRED OR ILLEGIBLE TEXT OR DRAWING**
- SKEWED/SLANTED IMAGES**
- COLOR OR BLACK AND WHITE PHOTOGRAPHS**
- GRAY SCALE DOCUMENTS**
- LINES OR MARKS ON ORIGINAL DOCUMENT**
- REFERENCE(S) OR EXHIBIT(S) SUBMITTED ARE POOR QUALITY**
- OTHER:** \_\_\_\_\_

**IMAGES ARE BEST AVAILABLE COPY.**

**As rescanning these documents will not correct the image problems checked, please do not report these problems to the IFW Image Problem Mailbox.**